



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,264	03/07/2000	Michael C. Weaver	004528.P001	1291

500 7590 03/09/2004

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 6300
SEATTLE, WA 98104-7092

EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2171

DATE MAILED: 03/09/2004

21

Please find below and/or attached an Office communication concerning this application or proceeding.

DM

Office Action Summary

Application No.

09/520,264

Applicant(s)

WEAVER ET AL.

Examiner

Susan Y Chen

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. This is in response to amendment filed on 12/08/2003 (paper # 20).
2. Claims 1-49 pending for examination, claims 1- 49 have been canceled; claims 50-95 are newly added.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 50-95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As claims 50 (line 3), 69 (line 3), 75 (line 5), 79 (line 6) and 85 (line 3), the claimed subject matter "external information system" is indistinct, because according to Fig. 1 of instant application, there are a plurality of Information systems, for example the units: 110, 114, 130, etc., however, applicant fails to disclose which one is the external/internal information system?

As to claims 56, 70, 76 and 81, it is not understood what does the claimed "prior to commencement of the legal proceeding" refer to [i.e., applicant fails to disclose when is the time of the claimed "commencement of the legal

Art Unit: 2171

proceeding", thus, it makes the claimed "prior to commencement of the legal proceeding" to be indistinct].

As to claim 51-68, 70-74, 76-77, 80-84 and 86-95, these claims have the same defect as their base claim, hence are rejected for the same reason.

4. Because of the ambiguous nature of the claimed features, therefore no prior art rejection is applied to claims 56, 70, 76 and 81 at this office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 50-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck et al. (U.S. Patent. No. 6,332,154), in view of Kumar (U.S. Patent. No. 6,353,823).

As to claim 50, Berk discloses a method in a computer system [e.g. Fig(s). 1-8] for analyzing data produced for legal purposes [e.g., 191, 193, Fig. 7; col. 22, lines 12-14] comprising:

Art Unit: 2171

a) receiving, from an external information system [e.g., the fax system at col. 22, line 10], a plurality of electronic files that are subject to a legal proceeding [e.g., col. 22, lines 12-14, Fig. 7];

b) storing the received electronic files in a searchable format [e.g., col. 10, lines 16 - col. 11, line 21; 191, Fig. 7, col. 21, lines 57 – col. 22, line 2];

c) storing metadata associated with the received electronic files [e.g., 275, Fig. 12; col. 31, lines 65-67; col. 32, lines 16-22];

c) receiving a request for electronic files having a specified characteristic [e.g., Fig. 13; col. 33, lines 9 – col. 34, line 14];

d) processing the metadata to determine a set of electronic files having the specified characteristic [e.g., the Interaction Object model (IOM, 253, Fig. 12; col. 31, lines 49 – col. 33, line 8].

Berk did not specifically disclose the technique to indexing metadata.

However, Kumar disclosed the technique to indexing metadata [e.g., the Metadata File Index 10, Fig. 1; Fig. 3; col. 6, lines 18-20; col. 7, lines 41-58].

Thus, it would have been obvious to one of the ordinary skill person in the art at the time the invention was made to further modify the combined system of Berk and Kumar to include an indexing metadata as claimed by applicant. An ordinary skilled artisan at the time the invention was made would have been motivated to do so, because the indexed metadata will store associative information of the file and provides information useful for later search processing [col. 7, lines 20-24].

As to claims 51-52, except the features as recited in claim 50, the combined system further discloses the method of returning an indication of the determined set of electronic files which matching the specified characteristic [e.g., Kumar: col. 4, line 43-51];

As to claim 53, except the features as recited in claims 50, the combined system further discloses the method of storing and indexing the metadata including storing and indexing the metadata in a database [e.g., Kumar: col. 7, lines 15-20, lines 37-40].

As to claim 54, except the features as recited in claim 50, the combined system further discloses the received electronic files is stored in a searchable text format [e.g., Kumar: col. 2, lines 29 – 38];

As to claim 55, the claimed feature -- legal proceeding is at least one of a lawsuit, a mergers, an acquisitions proceeding and a due diligence effort – is the default nature of proceeding for legal paper.

As to claim 57, except the features as recited in claim 50, the combined system further discloses the method of storing and indexing metadata associated with the received electronic files includes storing and indexing threading information associated with the emails [e.g., Kumar: the unit 107 of the Metadata File Index (10, Fig. 3); col. 7, lines 52-53].

As to claim 58, except the features as recited in claim 50, the combined system further discloses the method of receiving the plurality of electronic files including receiving word-processing file from the external information system [e.g., Kumar: the e-mail from the external e-mail system, col. 13, lines 22-27].

As to claim 59, except the features as recited in claim 50, the combined system further discloses the method of storing and indexing metadata associated with the received electronic files including storing and indexing metadata associated with a native format of the received electronic files [e.g., the unit 109 of the Metadata File Index (10, Fig. 3); col. 7, lines 53-55].

As to claim 60, except the features as recited in claim 50, the combined system further discloses the method of the following steps:

a) recursively extracting the plurality of electronic files from a data structure provided from the external information system [Beck: col. 37, lines 23-27; Kumar: col. 13, lines 13-21];

b) obtaining and indexing the metadata from each of the recursively extracted electronic files [Kumar: col. 13, lines 28-35];

c) convert the recursively extracted electronic files to a standard format [e.g., Kumar: col. 16, lines 39-44; Note: a standard format is obviously including the claimed read-only format];

d) indexing textual content of the extracted electronic files to provides the searchable format [e.g., Kumar: col. 16, lines 25-30].

As to claim 61, except the features as recited in claims 50 and 60, the combined system further discloses the method of the following steps:

a) storing the emails in a read-only format and in the searchable format [e.g., Kumar: 107, 109, Fig. 3; col. 7, lines 52-55; Note: the various format is obviously including the claimed read-only format];

b) separately storing the attachments in a read-only format and in the searchable format [e.g., Kumar: 103, 107, 109, Fig. 3];

c) storing and indexing metadata associated with the attachments [10, Fig. 3].

As to claims 62 and 63, except the features as recited in claims 50 and 60, the combined system further discloses the method of recursively extracting the plurality of electronic files from the external system is in response to a production request during the legal proceeding by using application programs [Beck: col. 22, lines 12-14; col. 37, lines 23-27; Fig(s). 10-14; Kumar: col. 1, lines 29-32; col. 13, lines 13-21; Fig. 7].

As to claims 64 -65, except the features as recited in claim 50, the combined system further discloses providing a user interface to display and apply at least one of the annotations including a responsive preparation selections to

Art Unit: 2171

the electronic files having the specified characteristic and that are responsive to the request. [e.g., Beck: Fig. 14 and associated text].

As to claims 66-67, except the features as recited in claim 50, the combined system further discloses providing a summary information indicative of electronic files that are available to be searched and processed to determine the set of electronic files having the specified characteristic [e.g., Kumar: Fig. 3 and associated text].

As to claim 68, except the features as recited in claim 50, the combined system further discloses receiving a request that specifies at least the properties information associated with the electronic file [e.g., Beck: col. 33, lines 17-19].

As to claims 69 and 71-72, these claims recite the same features as claims 50-55 and 57-68, hence are rejected for the same reason.

As to claims 73, except the features as recited in claim 69, the combined system further discloses the method of the following steps:

a) determining which versions of the applications can respectively read the electronic files in the data structure [e.g., Beck: Fig(s). 9-11; Kumar: col. 13, lines 30-35; steps: 200 – 270, Fig. 4];

b) using the determined versions of the applications to read their respective electronic files [e.g., Beck: Fig. 9-11; Kumar: steps 200 – 270, Fig. 4].

As to claims 74, except the features as recited in claim 69, the combined system further discloses the method of the following steps:

- a) receiving a query for electronic files having a specified characteristic [e.g., Kumar: 300, Fig. 7];
- b) returning a response to the query, the response being indicative of electronic files that have the specified characteristic [e.g., Kumar: 360, Fig. 7];
- c) presenting a copy of at least one of these electronic files in a user interface [e.g., Kumar: Fig. 5] along with annotation selections to apply to that copy of that electronic file [e.g., Kumar: col. 10, lines 17-34; Note: a ordinary skilled artisan will obvious set the GUI annotation selections as legal annotation selections based on business needs].

As to claims 75, 77- 80, and 82-95, the claimed computer system product and means are deem to be made obvious by the implementation of method claims 50-55 and 57-74, in the combination discussed above, hence are rejected for the same reasons.

Response to Arguments

6. Applicant's arguments with respect to the canceled claims 1-49 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Art Unit: 2171

7. To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is

Art Unit: 2171

(703) 308-1155. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703) 308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Chen
Feb. 25, 2004



UYEN LE
PRIMARY EXAMINER